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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/741,136

12/15/2000

Brian Von Herzen

6456

26362

7590

12/20/2004

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EXAMINER

POINVIL, FRANTZY

ART UNIT

PAPER NUMBER

3628

DATE MAILED: 12/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/741,136

Applicant(s)

HERZEN ET AL.

Examiner

Frantzy Poinvil

Art Unit

3628

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 62--90 is/are pending in the application.
- 4a) Of the above claim(s) 80-86 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 67-79 and 87-90 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 62-70, 74-79 and 87-90 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gregory (US Patent No.5,909,673) or Troy et al. (US Patent No. 4,689,742) considered with CD Computing News, Boston: December 1, 1998, Vol. 1'2, Issue 12, page 1.

As per claims 62 and 77, steps or means for printing a financial instrument at a user terminal from a central source is old and well known in the art. The financial instrument may be in response to the user requesting the check or coupon or in response to a user winning a game, the central computer electronically transmits the financial instrument which includes a medium bearing trusted indicia of a payment obligation to the bearer of the medium. Applicant is directed to the teachings of Gregory or Troy. Both Gregory and Troy do not explicitly state that the financial instrument is a rebate coupon being offered to a customer or user in consideration for performance of an obligation of a specified rebate transaction.

A rebate transaction includes an agreement by the user to accept specific terms for use of a product or service and the performance of the obligation includes

performance by the user of an action intended to legally bind the user to the agreement; and receiving information from the user confirming performance of the obligation is old and well practiced in the art. Applicant is directed to the teachings provided in the article by CD Computing News entitled a manufacturer offers a "\$300 rebate on CD Rocket 8X CD-Recorder". The article states "Consumer rebate fulfillment is subject to terms and conditions listed on the rebate coupon". See page 1 of the article.

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teachings provided by CD Computing News into the teachings of Gregory or Troy in order to provide instant credit or coupons to customers or users once they have fulfilled certain conditions thereby allowing instant uses of the coupons or rebates.

As per claims 63, 64, 65, 78 and 89, the teachings of Gregory, Troy and CD Computing News are given above. The combination does not explicitly teach the action intended to legally bind the user includes removing opaque material from a tangible medium to reveal a code printed thereon. As per this feature, certain products such as software products usually contain a registration code that is revealed to the user only when the user scratches an opaque material from a tangible medium in order to reveal the code printed thereon. Such would have been obvious to one of ordinary skill in the art to do in the combination above in order to provide a user the code for activating a software product which is when done results in a legal contract with the manufacturer or retailer of the software product. The tangible medium usually includes text warning the user of consequences associated with uncovering the code.

As per claim 66, Gregory teaches the rebate coupon is generated by printing on a general purpose printer to the user; and the trusted indicia consists substantially of substantially nonmagnetic visually indicia formed on a plain paper medium by the printer, the indicia including identification of a financial account containing funds of the rebate and an amount of funds that are authorized to be drawn from the financial account as the rebate. Note column 8, line 21 to column 9, line 11 and column 21, line 3 to column 22, line 57 of Gregory. Applicant is also directed to column 10, line 1 to column 11, line 10 and column 12 lines 8-30 of Troy.

As per claims 67 and 68, both Gregory and Troy teach the indicia includes identification of the user as the payee of the financial instrument, and an identification of an entity or financial institution that controls funds of the financial account.

As per claim 69, the combination above does not explicitly teach the indicia further includes security markings that are configured to change appearance when optically duplicated. Gregory suggests using a plain security feature "which may have background color or printing or distinctive water marks or other overall indicia". It would have been obvious to one of ordinary skill in the art at the time of the invention to provide security papers that change appearance when optically duplicated in the combined system above in order to automatically and instantly show fraud of a duplicated or unauthorized coupon or financial instrument.

As per claims 70, 74 and 75, Gregory teaches providing the user with a password (or authorization code) for printing the financial instrument. See column 12, lines 11-26. Troy teaches providing a user with a code before printing a financial

instrument. See column 12, lines 8-30 of Troy. In both Gregory and Troy, the code is transmitted from/to a central server that may act as an intermediary that controls the printing of the financial instrument.

As per claims 76, 79 and 90, the combination of Gregory or Troy and CD Computing News does not explicitly state maintaining a list of payment. Maintaining a list of payment would have been obvious to one of ordinary skill in the art to do in the combination of Gregory or Troy and CD Computing News in order to keep an update system in acknowledging which customers have redeem their rebate. After presentation of the financial instrument to a financial institution, both Gregory and Troy disclose a user may present their financial instrument to a financial institution for redemption purposes. Permitting the user to draw the funds only if the list indicates that the user is authorized to draw and has not yet drawn the funds is not explicitly teach in the combination of Gregory or Troy and CD Computing News. Such would have been obvious to one of ordinary skill in the art to do in the combination therein in order to prevent a customer to redeem a rebate more than one time for security and inventory purposes.

As per claim 87, steps or means for printing a check or coupons at a user terminal from a central source is old and well known in the art. The check or coupons may be in response to the user requesting the check or coupon or in response to a user winning a game the central computer electronically transmits such a financial instrument which includes a medium bearing trusted indicia of a payment obligation to the bearer of the medium. Applicant is directed to the teachings of Gregory or Troy. Both Gregory

and Troy do not explicitly state that the financial instrument is a rebate coupon responsive to a user's action.

A user purchasing electronic apparel or software is sometimes required to provide registration data to the manufacturer so that the manufacturer may control marketing data and consumer behavior. Providing consumers with rebates or coupons as an incentive to purchase a product/service is well known in the art as such is known as types of sales promotions for enticing consumers to purchase certain items from a seller. Thus providing a user or buyer a rebate in exchange of an electronic work product is old and well practiced in the art.

Applicant is directed to the teachings provided in the article by CD Computing News, entitled a manufacturer offers a "\$300 rebate on CD Rocket 8X CD-Recorder". The article states "Consumer rebate fulfillment is subject to terms and conditions listed on the rebate coupon". See page 1 of the article.

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teachings provided by CD Computing News into the teachings of Gregory or Troy in order to provide instant credit or coupons to customers or users once they have fulfilled certain conditions thereby allowing instant uses of the coupons or rebates.

2. Claims 71-73 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gregory (US Patent No.5,909,673) or Troy et al. (US Patent No. 4,689,742) considered

with CD Computing News, Boston: December 1, 1998, Vol. 12, Issue 12, page 1, as applied to claim 67 above and further in view of Custy et al (US Patent No. 5,774,879).

As per claim 71, the teachings of Gregory, Troy and CD Computing News are discussed above. The combination of Gregory, Troy and CD Computing News does not explicitly teach downloading software from the server user terminal to signify a guarantee by the intermediary of the availability of funds. Custy et al. teach a system in which a teller at a bank requests to print a financial instrument from a server. The server transmits software data to the teller terminal or to a printer for controlling the operation of the user terminal or printer. See column 7, line 5 to column 8, line 47 and column 10, lines 30-48 of Custy et al. It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teachings of Custy in the combination of Gregory or Troy and CD Computing News in order to induce customers to proceed with the requirements of the rebate system.

As per claim 72, most coupon manufacturers usually allow a single copy of a rebate coupon to be printed at a printer. Doing the same in the combination of Gregory or Troy, CD Computing News and Custy et al. would have been obvious to one of ordinary skill in the art with the motivation of controlling unauthorized or duplicate copies of the rebate coupon.

As per claim 73, Custy et al disclose using their system in a network environment. The second user terminal implements functions of a web browser and the software executes within a run-time environment of the web browser would have been obvious to one of ordinary skill in the art to do in the combination of Gregory or Troy,

CD Computing News and Custy et al. in order to enable remote access of the system to anyone having a computer terminal.


Conclusion

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frantzy Poinvil whose telephone number is (703) 305-9779. The examiner can normally be reached on Monday-Thursday.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

FP
December 4, 2004


FRANTZY POINVIL
PATENT EXAMINER
AU 3628